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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/864,976 | 05/24/2001 | Evan E. Koslow | 369.7217USU | 3444 |

30546 7590 09/22/2004

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| EXAMINER |
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BOYD, JENNIFER A

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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/864,976 | Applicant(s) KOSLOW, EVAN E. | |
| | Examiner Jennifer A Boyd | Art Unit 1771 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 10-16 is/are allowed.
 6) ☒ Claim(s) 1-9, 17-25 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's Amendments and Accompanying Remarks, filed June 21, 2004, have been entered and have been carefully considered. In view of Applicant's Amendments and Arguments, the Examiner withdraws the rejections of claims 10 – 16 as detailed in paragraphs 3 – 5 of the previous Office Action dated January 21, 2004. Claims 1, 10, 11, 17 and 21 are amended and claims 1 – 25 are pending. The invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102/103

3. Claims 1 – 3, 6 – 9, 17 – 18 and 21 – 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Koslow (U.S. 6,015,608). The details of the rejection can be found in paragraph 3 of the previous Office Action dated January 21, 2004. The rejection is maintained.

Claim Rejections - 35 USC § 103

4. Claims 4 – 5, 19 – 20 and 24 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koslow (U.S. 6,015,608). The details of the rejection can be found in paragraph 5 of the previous Office Action dated January 21, 2004. The rejection is maintained.

Allowable Subject Matter

5. Claims 10 – 16 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter:
Although Koslow (US 6,015,608) is found to be the most pertinent prior art, Koslow fails to teach or suggest that the channels of SAP particles are formed *upon contact with a liquid*. Koslow teaches, on the other hand, channels that are formed prior to any liquid contact.

Response to Arguments

7. In response to Applicant's remarks about the previously withdrawn 35 USC 102(b) rejection, the Examiner notes that the currently held rejection although over the same reference to Koslow (US 6,015,608) is different. The currently held rejection is a 35 USC 102/103 rejection rather than the 35 USC 102 rejection set forth in the Office Action dated March 12, 2003 and maintained in the Office Actions dated July 16, 2003.
8. In response to Applicant's argument that Koslow does not suggest or motivate one of skill in the art to use super absorbent polymer particles that form three-dimensional arrays of elongated channels upon contact with liquid, the Examiner respectfully submits that the end product of the present invention and Koslow is the same. It should be noted that the Applicant is attempting to introduce method limitations into an article claim. Because the claim is drawn to an article, the Examiner is not required to give weight to how the channels are made, only that the channels are present in the final product absent any evidence that would determine that the channels of Koslow are different structurally than the channels of the present invention.

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Additionally, the Applicant has failed to differentiate the structure or composition of the SAP particles from the prior art. The prior art has met the limitations of a bonded mixture comprising a mixture of binder particles and super-absorbent polymer particles (Koslow, column 2, lines 35 – 45). The Applicant has given no other physical limitations for comparison to the prior art for the bonded mixture, therefore, the Examiner assumes that the “spontaneous channel forming” property would be inherent. If said property is not inherent, it is asserted that Applicant’s claims must be incomplete. In other words, if Applicant’s asserts a lack of inherency in the prior art product, then Applicant’s claimed invention is missing an element that is critical to the invention, which would patentably distinguish it from the known prior art. It is suggested to the Applicant to provide additional details in the claims that would physically differentiate the prior art product from the instant invention rather than merely stating properties that result from a particular presently unknown structure. The Applicant has indicated in the Specification that certain types of SAP exhibit the claimed property (Specification, page 5, paragraph 5) such as SAP grade SP-1224. It is highly suggested to include this in the independent claim limitations along with any other structural features that would cause the “spontaneous channel forming” property.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 571-272-1473. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jennifer Boyd
September 15, 2004


Ula C. Ruddock
Primary Examiner
Tech Center 1700